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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,265	10/07/2003	Michael Merves	A8130.0135/P135	3136

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DICKSTEIN SHAPIRO LLP  
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EXAMINER

TYSON, MELANIE RUANO

ART UNIT PAPER NUMBER

3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/679,265	<b>Applicant(s)</b> MERVES, MICHAEL	
	<b>Examiner</b> Melanie Tyson	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 February 2007 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to amended independent claims 1, 11, and 19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The location of the "cavity" is unclear. Applicant claims "a cavity *adjacent* the handle," while Figure 1 clearly shows the cavity (49) is *within* the handle (99).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4-12, and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Modesitt et al. (Patent No. 6,136,010). Modesitt et al. disclose a suture device (see entire document) comprising an elongated shaft (for example see Figures 1, 2, and 5) having a proximal end (from element 16 back) and a distal end (from element 16 forward) capable of accommodating an implantable device such as a suture anchor or implant, a handle (12/18) provided at the proximal end, a cavity within the handle (12/18) for storing at least a strand of suture (34; for example, see column 6, lines 63-67) provided with a needle (38), a slot (52) for storing the needle (38), and a hatch (24) having a tie-down bar attached to its inside (center portion between openings 52), wherein the hatch (24) pivots to form an angle with respect to the longitudinal axis of the elongated shaft. Figure 3A shows the hatch (24) forms a zero degree angle with respect to the longitudinal axis of the elongated shaft when in the closed position (or in other words is *integral* with the handle), and the needle (38) is stored within the handle (12/18) when the pivotable hatch (24) is in the closed position. Figure 3B shows the hatch (24) forms an angle of about 10 degrees to about 170 degrees with respect to the elongated shaft when in the open position (or in other words is *not integral* with the handle).

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6. Claims 1, 11, 13, and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Keane et al. (Publication No. 2003/0204195 A1). Keane et al. disclose a suture device (see entire document) comprising an elongated shaft (for example see Figure 3; element 9) having a proximal end and a distal end, a handle (8) provided at the proximal end, a cavity (13) within the handle (8) for storing at least a strand of suture (6) provided with a needle (for example, see Figure 1; element 7), a slot (3) for storing the needle (7), a hatch (11) having a tie-down bar (1) attached to its inside (for example, see Figure 7), and at least one strand of suture (6) wrapped, or coiled, around the tie-down bar (1). The pivotable hatch (11) is *configured to* pivot together with the tie-down bar (1) on its inside since the tie-down bar (1) is capable of pivoting as the hatch (11) pivots.

With respect to claims 19-22, Keane et al. further disclose actuating the pivotable hatch (11) so that it forms an angle of about 10 degrees to about 170 degrees with respect to the longitudinal axis of the elongated shaft (9), attaching an implantable device (10) to the surgical suture (6), and deploying the suture (6) from around the tie-down bar (for example, see Figures 2, 7, and 9, and paragraphs 32, 42, and 45).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571) 272-9062. The examiner can normally be reached on Monday through Friday 9:00 a.m. - 5:30 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson *MT*  
March 22, 2007

*[Signature]*  
**ANH TUAN T. NGUYEN**  
**SUPERVISORY PATENT EXAMINER**

*3/26/07*